

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Mark D. Ackerman et al.

Title: SYSTEM AND METHOD FOR CONTROLLING ACCESS TO LICENSED COMPUTING PROCESSES VIA A CODIFIED ELECTRONIC LICENSE

Docket No.: 1565.039US1  
Filed: October 9, 2001  
Examiner: Behrang Badii



Serial No.: 09/973,664  
Due Date: March 13, 2006  
Group Art Unit: 3621

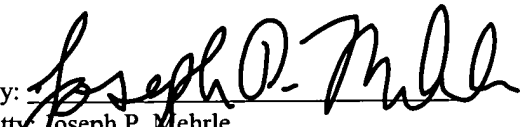
**MS Appeal Brief - Patents**  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

We are transmitting herewith the following attached items (as indicated with an "X"):

- ☒ Appeal Brief Under 37 C.F.R. 41.37 including authorization to charge Deposit Account 19-0743 in the amount of \$500.00 to cover the Appeal Brief fee (22 pgs.).
- ☒ Petition for Extension of Time (1 pg.) including authorization to charge Deposit Account 19-0743 in the amount of \$1020.00 to cover the Extension of Time Fee.
- ☒ Return postcard.

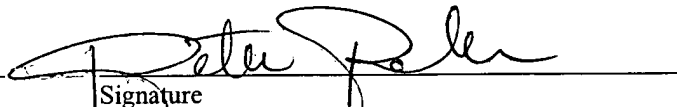
Please consider this a **PETITION FOR EXTENSION OF TIME** for sufficient number of months to enter these papers and please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
Customer Number 21186

By:   
Atty: Joseph P. Mehrle  
Reg. No. 45,535

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of March, 2006.

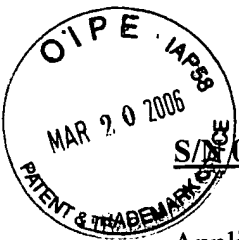
  
Name

  
Signature

**APPEAL BRIEF UNDER 37 C.F.R. § 41.37**

**TABLE OF CONTENTS**

	<u>Page</u>
<b><u>1. REAL PARTY IN INTEREST</u></b> .....	2
<b><u>2. RELATED APPEALS AND INTERFERENCES</u></b> .....	3
<b><u>3. STATUS OF THE CLAIMS</u></b> .....	4
<b><u>4. STATUS OF AMENDMENTS</u></b> .....	5
<b><u>5. SUMMARY OF CLAIMED SUBJECT MATTER</u></b> .....	6
<b><u>6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL</u></b> .....	8
<b><u>7. ARGUMENT</u></b> .....	9
<b><u>8. SUMMARY</u></b> .....	14
<b><u>CLAIMS APPENDIX</u></b> .....	15
<b><u>EVIDENCE APPENDIX</u></b> .....	20
<b><u>RELATED PROCEEDINGS APPENDIX</u></b> .....	21



S/N 09/973,664

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Mark D. Ackerman et al.	Examiner:	Behrang Badii
Serial No.:	09/973,664	Group Art Unit:	3621
Filed:	October 9, 2001	Docket No:	1565.039US1
Title	SYSTEM AND METHOD FOR CONTROLLING ACCESS TO LICENSED COMPUTING PROCESSES VIA A CODIFIED ELECTRONIC LICENSE		

PETITION FOR A THREE-MONTH EXTENSION OF TIME

MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

In accordance with the provision of 37 CFR § 1.136(a), it is respectfully requested that a three-month extension of time be granted in which to respond to the Notice of Appeal mailed October 11, 2005 and received by the USPTO on October 13, 2005, said period of response being extended from December 13, 2005 to March 13, 2006.

**Please charge Deposit Account No. 19-0743 in the amount of \$1020.00 to cover the required extension fee. Please charge any additional fees or credit overpayment to deposit Account No. 19-0743.**

Respectfully Submitted

MARK D. ACKERMAN ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(513) 942-0224

Date:

03/13/06 By: Joseph P. Mehrle  
Joseph P. Mehrle  
Reg. No: 45,535

CERTIFICATE UNDER 37 CFR § 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of March 2006.

Name:

Peter R. Rafferty

Signature:

Peter R. Rafferty



**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Mark D. Ackerman et al. Examiner: Behrang Badii

Serial No.: 09/973,664

Group Art Unit: 3621

Filed: October 9, 2001

Docket: 1565.039US1

**SYSTEM AND METHOD FOR CONTROLLING ACCESS TO LICENSED  
COMPUTING PROCESSES VIA A CODIFIED ELECTRONIC LICENSE**

---

**APPEAL BRIEF UNDER 37 CFR § 41.37**

Mail Stop Appeal Brief- Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

The Appeal Brief is presented in support of the Notice of Appeal to the Board of Patent Appeals and Interferences, filed on November 11, 2005 and received by the U.S. Patent Office on November 13, 2005, from the Final Rejection of claims 1-22 of the above-identified application, as set forth in the Final Office Action mailed on August 10, 2005.

The Commissioner of Patents and Trademarks is hereby authorized to charge Deposit Account No. 19-0743 in the amount of 500.00 which represents the requisite fee set forth in 37 C.F.R. § 41.2(b)(2). The Appellants respectfully request consideration and reversal of the Examiner's rejections of pending claims.

03/21/2006 DEMMANU1 00000004 190743 09973664

01 FC:1402 500.00 DA

## **1. REAL PARTY IN INTEREST**

The real party in interest of the above-captioned patent application is the assignee, Novell, Inc. as evidenced by the assignment from the inventors to Volera, Inc. and recorded October 9, 2001 on Reel 012251, Frame 0955 and the assignment from Volera, Inc. to Novell, Inc. recorded July 21, 2003 and recorded on Reel 014293, Frame 0075.

## **2. RELATED APPEALS AND INTERFERENCES**

There are no other appeals or interferences known to Appellants that will have a bearing on the Board's decision in the present appeal.

### **3. STATUS OF THE CLAIMS**

The present application was filed on October 9, 2001 with claims 1-22. A Final Office Action (hereinafter “the Final Office Action”) was mailed August 10, 2005 rejecting claims 1-22. Claims 1-22 stand twice rejected, remain pending, and are the subject of the present Appeal.

#### **4. STATUS OF AMENDMENTS**

No amendments have been made subsequent to the Final Office Action dated  
August 10, 2005



## **5. SUMMARY OF CLAIMED SUBJECT MATTER**

Some aspects of the present inventive subject matter include, but are not limited to, systems, methods, and media for electronic licensing.

According to one aspect, a system for licensing external processes on a computer is provided as illustrated in FIGS. 2-7. An electronic license, as illustrated in FIG. 4, includes two or more software commands for registration with a software product. See FIG. 4, item 470 (commands to register), page 14 lines 19-25 and continuing through page 16. The software license includes embedded therein for each software command a string identifying a command name and at least one of an inclusion and exclusion identifier. Page 16 lines 7-12. The system also includes an interface that registers the identified software commands having the inclusion identifier. FIG. 2, items 255 and 257. Furthermore, the system includes a command processor that executes the identified and registered software commands. Fig. 2, item 254, page 8 lines 11-18, and page 19 lines 20-23.

In another aspect, a method for licensing external processes on a server is presented, as illustrated in FIGS. 4-7. Here, an electronic license is generated that includes a plurality of software command directives embedded therein for at least one of accessing and rejecting registration, by one or more external processes or products having the software commands. FIG. 5, block 520 and page 17 lines 3-8; and FIG. 4. Each command directive includes a command name associated with one or the plurality of software commands and an inclusion or exclusion identifier for the acceptance or rejection of the registration. See page 16 lines 7-21. The software commands are registered based upon the software command directives. Page 19 lines 20-23. Finally, the registered commands are executed. FIG. 7, block 760 and page 19 line 20 continuing to page 20 line 1.

In yet another aspect, a computer-readable medium includes program instructions executing on a computer for licensing external processes on a server, the program

---

performs the method as follows. FIGS. 5-7; also see page 20 last full paragraph. An electronic license is generated that identifies two or more software commands for registration for a product. FIG. 5, block 520 and page 17 lines 3-8; and FIG. 4. The electronic license includes for each software command a string identifying a command name for one of the software commands and at least one of an inclusion and exclusion identifier, where the string is embedded within the electronic license. See page 16 lines 7-21 and FIG. 4, item 470. Next, the software commands are registered with an interface for those having the inclusion identifier. Page 19 lines 20-23. Then, a command processor executes the identified and registered software commands. FIG. 7, block 760 and page 19 line 20 continuing to page 20 line 1.

This summary does not provide an exhaustive or exclusive view of the present subject matter, and Applicants refer to the appended claims and its legal equivalents for a complete statement of the invention.

## **6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

- A. Claims 1, 6, 10, 15, and were rejected under 35 USC § 103(a) as being unpatentable over Haruki (U.S. Publication No. 2001/003099) in view of Goldick (U.S. Publication No. 2002/0123992).
- B. Claims 2-5, 9, and 11 were rejected under 35 USC § 103(a) as being unpatentable over Haruki and Goldick and in further view of Misra (U.S. Patent No. 6,189,146).
- C. Claims 7 and 8 were rejected under 35 USC § 103(a) as being unpatentable over Haruki and Goldick and in further view of Garst (U.S. Patent No. 6,188,995).
- D. Claim 12 was rejected under 35 USC § 103(a) as being unpatentable over Haruki and Goldick and in further view of Muyres (U.S. Publication No. 2001/0010046).
- E. Claims 13 and 14 were rejected under 35 USC § 103(a) as being unpatentable over Haruki and Goldick and in further view of Carter (U.S. Patent No. 6,219,652).
- F. Claims 16-21 were rejected under 35 USC § 103(a) as being unpatentable over Haruki and Goldick and in further view of Misra.

## **7. ARGUMENT**

### **A) The Applicable Law under 35 U.S.C. §103(a)**

To sustain a rejection under 35 U.S.C. 103, references must be cited that teach or suggest all the claim elements. M.P.E.P. § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)). In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02.

Further, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991); MPEP § 2143. The Examiner must avoid hindsight. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The Office Action must further provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

### **B.) References Cited**

**Haruki** discloses techniques for software license management, an electronic device, and recording medium. Haruki uses a secret area of a special playback device to store license data and a management flag. Haruki, paragraph 41. The license data and the management flag are separate structures. A value of 1 is needed for the management flag in order for the license data to be acquired. The point of Haruki is to provide a technique for a device (the playback device) where media data is played and installed

once. To achieve this, Haruki uses both license data and a flag both of which are managed and controlled in secret areas of a playback device and accessed and manipulated by a controller of that playback device. The software discussed in Haruki deals exclusively with playing media data and functions are discussed within the context of transferring data or installing data. Haruki relies on a playback device with a secret memory or storage to house license data and a management flag. Haruki also relies on a controller to manage inspecting the secret area and to manage setting and resetting the management flag.

**Goldick** discloses techniques for creating and maintaining version-specific properties in a distributed environment. Properties are carried and managed in objects and objects are files or file-type data. Goldick, paragraph 33. Applications or software access the objects; the objects are not software. Software acts upon the objects to change or reset and take action on version-specific properties, which are carried within the objects. Goldick, paragraphs 38-39. The only mention or reference to software commands is supplied within a description of FIG. 1 where a basic computer environment within which the invention may be implemented is discussed. In paragraph 30, a user accesses input devices to enter commands. The commands in this context and the only context described in Goldick is not related or tied to the objects discussed in Goldick. Goldick discusses the terms “inclusionlist” and “exclusionlist,” which are types of specific object properties that are used to list other properties, which if present dictate whether the contents of a property should be cleared (set to empty – inclusionlist) or not reset (not set to empty – exclusionlist). Goldick, footnoted table after paragraph 51, see footnote numbers 5 (inclusionlist) and 13 (exclusionlist).

### **C) The Rejections under 35 U.S.C. § 103(a):**

Independent claims 1, 15, and 22 were rejected as being obvious in view of Haruki and Goldick. Each of the independent claims include limitations directed to two or more software commands within a license for a software product, where at least one of

those commands includes an inclusion or exclusion identifier, and the commands with the inclusion identifier are registered.

The Examiner asserts that Goldick teaches software commands for a software program having exclusion and inclusion identifiers for excluding or including those commands for the software program. Applicants have continued to assert that this combination in the first instances and assertion in the second instances is improper.

First, Goldick teaches a file or piece of data (object) that is not a software program, where the object carries version information or properties, which are managed by other applications. The software commands discussed in Goldick are used outside this context and provided solely to provide context of a user interacting with its teachings. In other words the software commands are not related to the objects and not discussed within that context at all. It is only the objects that include the inclusionlist and exclusionlist properties. The exclusionlist has a specific meaning described in footnote 13 after paragraph 51. There is no use of the word exclusion; rather a special term is called "exclusionlist" and it is not used in a manner consistent with the dictionary or the normal understood term of "exclusion." That is, "exclusionlist" identifies a list of other properties that if updated by an application should not cause that object's version-specific property's content to be reset to empty. In a similar manner, the term "inclusionlist" is a special created term within Goldick in footnote 5 after paragraph 51. Again, the term "inclusionlist" is not used in a manner consistent with the term "inclusion" as it would appear in the normal parlance. The term "inclusionlist" identifies a list of other properties that if updated within an object will result in another application being instructed to set the object's version specific property's contents to empty.

There is no mention of licensing or use of licensing within Goldick. Goldick is dealing with managing version-specific information or properties in general within a file or object. Thus, Applicants have asserted and continue to assert that there would have been no motivation to combine Haruki and Goldick together and especially not in the manner suggested by the Examiner. The two references are each dealing with separate issues; Haruki with licensing and Goldick with object versioning. Moreover, the

specialized terms “inclusionlist” and “exclusionlist” would have provided no motivation to one of ordinary skill in the art to flag specific software commands within the license data of Haruki to being included within the license or excluded. This is so because Goldick does not even use the terms “exclusion” or “inclusion;” Goldick uses specialized terms of “inclusionlist” and “exclusionlist” both of which do not have the meaning that the Examiner wants them to have. Stated another way, Goldick does not teach including or excluding commands with its “exclusionlist” and “inclusionlist” teachings; so, one of ordinary skill in the art would not have read Goldick and came to such a conclusion as the Examiner is asserting to be the case. The teaching of excluding or including software commands is not present at all in Goldick and it is not present in Haruki. Applicants respectfully assert that the only way in which the combination that the Examiner is asserting could be made, if at all, is via improper hindsight.

At best, a motivation to combine Goldick and Haruki would have resulted in dual purposes system with each being independent of the other. In other words, a playback device with licensing management via a secret store having license data and a management flag and a separate system for managing media objects via properties carried with those objects. Applicants believe even this is an unreasonable and illogical stretch and therefore Applicants assert that there is no proper established motivation for combining Haruki and Goldick. Thus, the combination is improper.

Also, Goldick desires to specifically carry metadata with the objects and Haruki desires to separate its management flag from its license data. These are core teachings of the two references. The teachings are not compatible if modifications are to be made to one of the teachings. Haruki wants to separate metadata (separate the license flag) and Goldick relies on metadata being carried with the object. So, again Applicants believe that one of ordinary skill in the art would not have been motivated to combine these two references since the teachings are not compatible with one another.

Second, even if the combination is determined to be proper. That combination still lacks a license having exclusion or inclusion identifiers where commands are included or registered for a software product within that license if associated with an

inclusion identifier. Neither Goldick nor Haruki teach exclusion or inclusion identifiers and neither teach including software commands for registration based on inclusion identifiers. Applicants respectfully disagree with the Examiner's use of terms "software commands," "inclusionlist," and "exclusionlist" entirely out of their described contexts within Goldick in order to arrive at a contrary conclusion. Thus, Applicants assert the proposed combination still lacks a teaching of each and every limitation of Applicants' independent claims. Therefore, the rejections with respect to the claims should be withdrawn.

**D. The Other Rejections Under 35 U.S.C. § 103(a):**

Claims 2-5, 7-9, 11-14, and 16-21 were rejected as being unpatentable over Haruki and Goldick in view of several other references. These claims are dependent from the independent claims discussed above. Therefore, Appellant asserts that these claims should be allowed in view of the arguments presented above with respect to the independent claims.



**8. SUMMARY**

It is respectfully submitted that the art cited does not render the independent claims of record anticipated and that the claims are patentable over the cited art. Therefore, reversal of the rejections and allowance of the pending claims are respectfully requested.

Respectfully submitted,

MARK D. ACKERMAN et al.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.

P.O. Box 2938

Minneapolis, MN 55402

Date

03/13/06

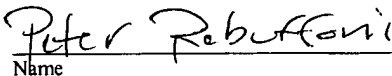
By



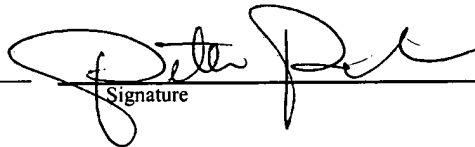
Joseph P. Mehrle

Reg. No. 45,535

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 13 day of March, 2006.



Name



Signature

### **CLAIMS APPENDIX**

1. (Rejected) A system for licensing external processes on a computer comprising:  
an electronic license that identifies two or more software commands for registration for a software product, wherein the electronic license includes embedded therein for each software command a string identifying a command name and at least one of an inclusion and exclusion identifier;  
an interface that registers the identified software commands having the inclusion identifier; and  
a command processor that executes the identified and registered software commands.
2. (Rejected) The system as set forth in claim 1 wherein the computer comprises a proxy cache server.
3. (Rejected) The system as set forth in claim 2 wherein the proxy cache server is part of a proxy cache server cluster that comprises a plurality of proxy cache servers interconnected over a network
4. (Rejected) The system as set forth in claim 2 wherein the electronic license further comprises one or more fields identifying a server version, the server version defining server models on which that the electronic license is valid.
5. (Rejected) The system as set forth in claim 1 wherein the electronic license includes one or more fields identifying a license expiration date, the license expiration date defining a period of time that the electronic license will allow access.

---

6. (Rejected) The system as set forth in claim 1 wherein the electronic license includes one or more fields identifying one or more hardware serial numbers, the hardware serial numbers corresponding to one or more computers on which the license is valid.

7. (Rejected) The system as set forth in claim 1 wherein the command includes means for restricting usage of predetermined hardware resources on the computer based upon the electronic license.

8. (Rejected) The system as set forth in claim 7 wherein the electronic license includes one or more fields identifying a set of hardware resources licensed for use, wherein only the set of hardware resources licensed for use will be used by the command processor in executing the identified and registered software commands.

9. (Rejected) The system as set forth in claim 1 wherein the electronic license comprises a license upgrade, the license upgrade including a software commands-to-register field identifying another set of software commands that the interface may register in addition to the software commands identified by one or more prior licenses.

10. (Rejected) The system as set forth in claim 1 wherein the electronic license is a license upgrade, the license upgrade containing one or more fields identifying additional hardware resources licensed for use.

11. (Rejected) The system as set forth in claim 1 wherein the electronic license is a license upgrade, the license upgrade containing one or more fields identifying hardware resources that add further capabilities to hardware resources previously licensed for use by one or more prior licenses.

---

12. (Rejected) The system as set forth in claim 1 wherein the electronic license is coded in Extensible Markup Language (XML) and defines a set of codified command directives that provide information that enables the interface to, either, accept or reject registration of the identified software commands.

13. (Rejected) The system as set forth in claim 1 wherein the electronic license includes a software commands-to-register field including means for identifying inclusion of a root software command, the root software command identifying all software commands that share the root software command for registration and the interface being adapted to register all software commands that share the root software command.

14. (Rejected) The system as set forth in claim 13 wherein the software commands-to-register field further includes means for identifying exclusion of a predetermined software command from the software commands that share the root software command so as to cause the interface to reject registration of the predetermined software command that is excluded.

15. (Rejected) A method for licensing external processes on a server comprising the steps of:

generating an electronic license that includes a plurality of software command directives embedded therein for at least one of accepting and rejecting registration, by one or more external processes or products having the software commands, and wherein each command directive includes a command name associated with one of the plurality of software commands and an inclusion or exclusion identifier for the acceptance or rejection of the registration; and

registering software commands based upon the software command directives; and  
executing the registered commands.

---

16. (Rejected) The method as set forth in claim 15 wherein the step of includes directing the one or more external processes to only use a set of licensed hardware resources, the set of licensed hardware resources being defined by one or more fields in the electronic license.

17. (Rejected) The method as set forth in claim 15 wherein the step of generating includes generating a license upgrade, the license upgrade defining a set of additional commands for registration that are not part of software commands registered in conjunction with one or more prior licenses.

18. (Rejected) The method as set forth in claim 15 wherein the step of generating includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that are not part of hardware resources licensed for use by prior licenses.

19. (Rejected) The method as set forth in claim 15 wherein the step of generating includes generating a license upgrade, the license upgrade describing additional hardware resources licensed for use by the one or more external processes that add further capabilities to hardware resources licensed for use by prior licenses.

20. (Rejected) The method as set forth in claim 15 further comprising either one of (a) installing the electronic license in the server prior to shipment of the server to an end-user of the server and (b) providing the electronic license to the end-user on a removable media for installation in the server after the shipment of the server to the end-user.

21. (Rejected) The method as set forth in claim 15 further comprising installing the electronic license in the server in a over-the-wire process including (a) digitally signing the electronic license by a vendor, (b) transmitting the digitally signed electronic license over a communications network from the vendor to the server, (c) validating the digitally signed electronic license by the server and (d) installing the validated electronic license in the server.

22. (Rejected) A computer-readable medium including program instructions executing on a computer for licensing external processes on a server, the program instructions performing the steps of:

generating an electronic license that identifies two or more software commands for registration for a product, wherein the electronic license includes for each software command a string identifying a command name for one of the software commands and at least one of an inclusion and exclusion identifier, wherein the string is embedded within the electronic license;

registering, with an interface, the identified software commands, which have the inclusion identifier in the electronic license; and

executing, with a command processor, the identified and registered software commands.

**EVIDENCE APPENDIX**

None.

**RELATED PROCEEDINGS APPENDIX**

None.